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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Daniel Kuzmich *et al.*

Examiner: D. Margaret Seaman

Serial No.: 10/739,208

Group Art Unit: 1625

Filed: December 18, 2003

Docket: 9/272

Customer No.: 28509

Confirmation No.: 1223

For: GLUCOCORTICOID MIMETICS, METHODS OF MAKING THEM,
PHARMACEUTICAL COMPOSITIONS, AND USES THEREOF

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

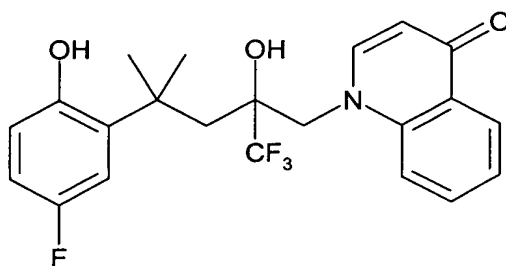
REPLY TO RESTRICTION REQUIREMENT

Sir:

This Reply is filed in response to the Office Action dated April 10, 2006. In that Office Action, a one month shortened statutory period was set for response, and this response is timely. If it is determined that any fees under 37 C.F.R. §§ 1.16 or 1.17 are due in connection with this Reply, however, authorization is hereby given to charge such fees to Deposit Account No. 02-2955. In addition, applicants also request that any subsequently filed reply requiring a petition for an extension of time for its timely submission be treated as if it incorporated such petition for an extension of time pursuant to the provisions of 37 C.F.R. § 1.136(a)(3) and hereby authorize that any fees due in connection therewith be charged to Deposit Account No. 02-2955.

In the Office Action dated April 10, 2006, the Examiner imposed a restriction requirement in the instant application. The Examiner alleged that the claims of the instant application included 32 independent and distinct inventions in Groups I to XXXII as set forth therein.

In response to that restriction requirement, applicants hereby elect with traverse to prosecute in this application the subject matter of Group I, claims 1 to 8 (in part), drawn to compounds of formula (IA) wherein R¹ is phenyl. Applicants also elect the species on page 17, first compound: 1-[4-(5-Fluoro-2-hydroxyphenyl)-2-hydroxy-4-methyl-2-trifluoromethylpentyl]-1H-quinolin-4-one having the following structure:



as the species for examination purposes. Applicants reserve the right to prosecute in one or more divisional applications whatever subject matter is not examined or allowed here.

Applicants, however, respectfully request that the Examiner reconsider and withdraw the restriction requirement as to Groups XIII, XIV, XV, and XVI (to the extent they are limited to compounds of Group I) for the reasons given below. Group I and Groups XIII, XIV, XV, and XVI (to the extent they are limited to compounds of Group I) are related as compounds of formula (IA) wherein R¹ is phenyl, pharmaceutical compositions including the compounds of formula (IA) wherein R¹ is phenyl, and methods for using compounds of formula (IA) wherein R¹ is phenyl. Therefore, Group I and Groups XIII, XIV, XV, and XVI (to the extent they are limited to compounds of Group I) are sufficiently related such that the search for relevant art for Group I would be expected to uncover prior art that is relevant to Groups XIII, XIV, XV, and XVI (to the extent they are limited to compounds of Group I), since these Groups involve the same compounds. Indeed, if Group I is found to be patentable over the prior art, Groups XIII, XIV, XV, and XVI (to the extent they are limited to compounds of Group I) are necessarily patentable over the prior art. Thus, a search for relevant art and subsequent examination would not be an undue burden on the Examiner and the restriction should be withdrawn. M.P.E.P. § 803. It is therefore respectfully requested that the Examiner withdraw the restriction of Group I and Groups XIII, XIV, XV, and XVI (to the extent they are limited to compounds of Group I).

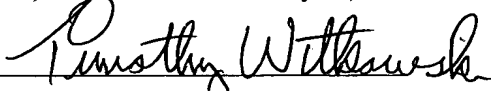
In any case, the claims of Groups XIII, XIV, XV, and XVI (to the extent they are limited to compounds of Group I) should be rejoined and allowed when the claims of Group I are found allowable over the prior art.

Applicants respectfully submit that all the pending claims are allowable and therefore solicit a Notice of Allowance for all of the pending claims. If the Examiner feels that a telephone

interview would be helpful in advancing prosecution of this application, the Examiner is invited to contact the attorney below.

Certificate of Mailing Under 37 C.F.R. § 1.8(a)

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on May 10, 2006.

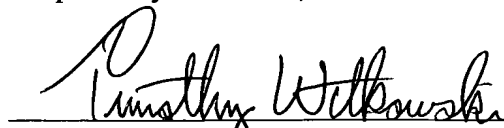


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5-10-2006

Dated

Respectfully submitted,



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